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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/733,628
Filing Date: December 11, 2003
Appellant(s): BONAVENTURA ET AL.

Robert C. Atkinson (57,584)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2007 (3/29/07) appealing from the Office action mailed November 8, 2005 (11/8/05). This is also in response to the panel remand to the Examiner by the BPAI dated February 12, 2007 (2/12/07).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. It is further noted that the appellant's statement now includes corresponding structure acts or materials for means-plus-function limitations in Claims 4 and 6, as requested in the remand dated 2/12/07.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,306,467	DOUGLAS-HAMILTON et al.	4-1994
5,781,338	KAPITZA et al.	7-1998
4,436,385	FISCHER et al.	3-1984
4,906,083	SATTLER	3-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 9-15, 17-20 are rejected under 35 U.S.C. 103(a). These rejections are set forth in the prior Office Action dated 11/8/05, and copied *infra*.

Claims 9, 11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. (U.S. Patent No. 5306467), in view of Kapitza et al. (U.S. Patent No. 5781338), of record.

Douglas-Hamilton et al. discloses a microscope stage (See Figures 1-4) comprising an upper stage (See 10 in Figure 1); and a non-transparent contrasting stage insert (See 20 in Figure 1; col. 4, lines 40-45) comprising a second color, the non-transparent contrasting stage insert comprising a portion of the upper stage background (See specifically Figure 2). Douglas-Hamilton et al. additionally discloses the non-transparent contrasting stage insert comprising a magnetic surface (See Figure 4); the upper stage comprising a recess and the non-transparent contrasting stage insert being operatively arranged for releasable complementary receipt therein (See 14, 10, 20 in Figure 1); the non-transparent contrasting stage insert comprising alignment

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means (See 24, 26 in Figure 1), such as recess pins and corresponding bores; and the non-transparent contrasting stage insert further comprising fastening means (See Figure 4). Douglas-Hamilton et al. does not explicitly disclose the upper stage comprising a first color. However, Kapitza et al. discloses a microscope stage (See Figures 1-3) comprising an upper stage comprising a first color, e.g. black as by black lacquer paint (See col. 1, lines 6-24), and including a recess therein (See for example 7 in Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the upper stage of the microscope stage of Douglas-Hamilton et al., comprise a first color, as taught by Kapitza et al., for the purpose of preventing contamination of the stage and maintaining the good appearance of the stage during use and storage.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. discloses the invention as set forth above in Claim 9, except for the non-transparent contrasting stage insert comprising a painted surface. However, as previously set forth above in Claim 9, Kapitza et al. teaches a microscope stage (See Figures 1-3) comprising an upper stage comprising a first color, e.g. black as by black lacquer paint (See col. 1, lines 6-24). The lacquer paint is used mainly to protect and maintain the surface finish of the stage during usage. One of ordinary skill would have known to protect other various parts of the microscope and microscope stage, such as stage inserts and sample holders, using the lacquer paint, to similarly protect and maintain the surface finish of these other various parts. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to have the non-transparent contrasting stage insert comprise a painted surface in the microscope stage of Douglas-Hamilton et al. in view of Kapitza et al., to protect and maintain the surface finish of the stage insert during use and storage.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. in view of Kapitza et al. discloses the invention as set forth above in Claim 9, except for the non-transparent contrasting stage insert comprising an adhesive film. However, the use adhesive films, magnets/magnetic surfaces and springed detents for use as releasable fastening means to allow for easy removal and attachment of items is well known and conventional in the art. For example, as previously set forth above, Douglas-Hamilton et al. discloses the non-transparent contrasting stage insert further comprising fastening means, such as magnets. Although the use of adhesive films is not specifically taught by Douglas-Hamilton et al. or Kapitza et al. for use as fastening means, such adhesive films, such as double-sided tape, is well known in the art for use in attachment applications. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the non-transparent contrasting stage insert comprise an adhesive film, to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. in view of Kapitza et al. discloses the invention as set forth above in Claims 9, 11, 13-15, except for the non-transparent contrasting stage insert not explicitly being removable. However, Douglas-Hamilton et al. additionally discloses that the non-transparent contrasting stage insert (See 20 in Figure 1 of Douglas-Hamilton et al.) may be inserted into the upper stage (See 10 in Figure 1 of Douglas-Hamilton et al.) by inserting the lateral extensions (See 24 in Figure 1 of Douglas-Hamilton et al.) on the legs of the stage insert into the bores (See 26 in Figure 1 of Douglas-Hamilton et al.) in the recess of the upper stage. Thus, it would be reasonable for one of ordinary skill to be able to similarly remove the stage insert from the upper stage by disengaging the lateral extensions on the legs of the stage insert from the bores of the recess of the upper stage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the non-transparent contrasting stage insert be removable, to allow for quick removal and replacement of the insert, during operation of the microscope, particular during times where the insert becomes damaged or a different insert is required.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al. as applied to Claims 1, 4, 9 above, and further in view of Fischer et al. (U.S. Patent No. 4436385).

Douglas-Hamilton et al in view of Kapitza et al. discloses the invention as set forth above in Claims 1, 4, 9, except for the releasable fastening means comprising a springed detent. However, the use adhesive films, magnets/magnetic surfaces and springed detents for use as releasable fastening means to allow for easy removal and attachment of items is well known and

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conventional in the art. For example, Fischer et al. teaches a conventional specimen holder for use in microscopes (See Abstract; Figures 1-3), wherein slidable holders (See 2a, 2b in Figure 1) for holding a specimen is releasably held in place at a particular position by springed detents (See 21a, 21b in Figure 1; col. 2, line 52-col. 3, line 4). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the releasably fastening means comprise a spring detent, as taught by Fischer et al., in the microscope stage of Douglas-Hamilton et al. in view of Kapitza et al., to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Sattler (U.S. Patent No. 4906083).

Douglas-Hamilton et al. discloses a device (See Figures 1-4) for providing contrast between a microscope stage (See 10 in Figure 1) and a specimen (See 21, 23, 25 in Figure 2A; col. 4, lines 9-15) comprising a microscope stage comprising a non-transparent contrasting stage insert having a first color (See 20 in Figure 1; col. 4, lines 40-45); and a specimen (See col. 4, lines 9-15). Douglas-Hamilton et al. additionally discloses the non-transparent contrasting stage insert being releasably secured to the microscope stage (See Figure 2), wherein the non-transparent contrasting stage insert comprises a releasable fastening means, such as a magnet (See Figure 4). Douglas-Hamilton et al. does not explicitly disclose the specimen having a second color being different from the first color of the non-transparent contrasting stage insert. However, it is well known in the art that many of the specimens examined by microscopes will have some color, which may be different from that of the stage (e.g. black) and/or a stage insert (e.g. silver, black).

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For example, Sattler teaches a conventional microscope for examining gemstones (See Abstract; Figures 1-2), wherein the gemstones (i.e. the specimen) may have a color that is different from the microscope stage (See 10 in Figures 1-2; col. 8, lines 3-28) or the sample holder/insert (See 54 in Figures 1-2; col. 4, line 60-col. 6, line 2) on which the sample is placed. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the specimen have a second color be different from the first color of the non-transparent contrasting stage insert, as taught by Sattler, in the device of Douglas-Hamilton et al., to allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen.

It is further noted that the disclosure currently appears to be sufficient under 35 U.S.C. 112, 1st and 2nd paragraphs, with regard to the 'springed detent' corresponding to the 'releasable fastener means' limitation of Claims 4 and 6.

(10) Response to Argument

The Appellant's arguments and remarks filed 4/14/06 in response to the final rejection, dated 11/8/05, have been fully considered, however, they are not found persuasive.

Firstly, it is the Appellant's belief that, with respect to Claims 1 and 9, as well as 2-5, 10-15 which depend on Claims 1 and 9, the Examiner has not provided any basis for combining the teachings of Douglas-Hamilton et al. and Kapitza et al. (See specifically Section 1)c1) on Pages 6-7 of the Brief filed 4/14/06). In particular, Appellant argues that no rationale or explanation was provided in the Final Office Action how the teachings of Douglas-Hamilton et al. and Kapitza et al. were selected and combined, and that no convincing line of reasoning providing a

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basis for combining Douglas-Hamilton et al. and Kaptiza et al. was provided independent of Appellant's own disclosure. However, it is the belief of the Examiner that appropriate basis for combining the teachings of Douglas-Hamilton et al. and Kapitza et al. was provided.

In the instant case, in establishing a case of *prima facie* obviousness (See MPEP 2143), there is no requirement to show how teachings in various references are selected, as argued by Appellant. With respect to a showing as to how the various teachings were combined, the Examiner noted that, in rejecting Claim 9, Douglas-Hamilton et al. did not explicitly disclose the upper stage comprising a first color. However, the Examiner turned to the teachings provided by Kaptiza et al., which teaches that such conventional stages may be lacquered black (See col. 1, lines 11-12 of Kaptiza et al.), specifically for the purpose of maintaining the stage's good appearance even if they become contaminated (e.g. dirt, liquids, spills, etc.). The Examiner notes that this particular reason or motivation to combine these teachings comes directly from Kapitza et al. As per MPEP 2144, such reason or motivation to combine may be different from Appellant's rationale. With respect to Claim 1, it was noted that though Douglas-Hamilton et al. and Kaptiza et al. did not explicitly disclose the non-transparent contrasting stage insert (See 20 in Figure 1 of Douglas-Hamilton et al.) being removable, it was reasoned that, since Douglas-Hamilton et al. discloses that such insert is inserted onto the upper stage (See 10 in Figure 1 of Douglas-Hamilton et al.), one of ordinary skill would similarly be able to remove the stage insert from the upper stage. It was further reasoned that the stage insert may be removed to allow for replacement of the stage insert, particularly where the insert becomes damaged or an alternative insert is required. The Appellant has not provided any evidentiary support to show why the

removal of the stage insert from the upper stage would not have been an obvious feat to one of ordinary skill in the art.

Secondly, it is the Appellant's belief that, with respect to Claims 1 and 9, as well as 2-5, 10-15 which depend on Claims 1 and 9, Douglas-Hamilton et al. fails to teach or reasonably suggest a microscope stage (See specifically Section 1)c)2) on Pages 7-9 of the Brief filed 4/14/06), as generally recited in the preamble of each of Claims 1 and 9. However, it is the belief of the Examiner that Douglas-Hamilton et al. does disclose what Appellant terms "a microscope stage".

Specifically, Appellant argues that Douglas-Hamilton et al. only describes placing a slide loading apparatus (See for example Figure 1 of Douglas-Hamilton et al.) onto the stage of a microscope, and that if such a device is placed on a microscope stage, that device cannot also be a microscope stage. The Appellant further argues that Douglas-Hamilton et al. does not illustrate or describe a microscope in their specification. However, it is pointed out that the recited claims do not recite a microscope, nor do the recited claims recite any distinguishing structural features related to a microscope. As previously set forth in the Final Office Action dated 11/8/05, Douglas-Hamilton et al. specifically discloses a device that has been broadly and reasonably interpreted to be "a microscope stage", including an upper stage (See 10 in Figure 1 of Douglas-Hamilton et al.), a non-transparent contrasting stage insert comprising a color (See 20 in Figure 1; col. 4, lines 40-45 of Douglas-Hamilton et al.), the non-transparent contrasting stage insert comprising a portion of the upper stage background (it is noted that when the device of Douglas-Hamilton et al., as shown in Figure 1, is generally viewed by an observer, particularly when the non-transparent contrasting stage insert is lowered against the upper stage, the non-transparent

contrasting stage insert contributes to the background image of the upper stage as viewed by the observer). In addition, Douglas-Hamilton et al. discloses the upper stage having a recess (See for example 14 in Figure 1 of Douglas-Hamilton et al.), and the non-transparent contrasting stage insert being operatively arranged for releasable complementary receipt therein (See 14, 10, 20 in Figure 1 of Douglas-Hamilton et al.). According to Douglas-Hamilton et al. (See col. 5, lines 7-17 of Douglas-Hamilton et al.), such device may be used in a manual microscope to allow a specimen for observation to be placed as close to the microscope condenser, thus allowing for use of the full range of available illumination optics. In essence, the device of Douglas-Hamilton et al., i.e. "a microscope stage" that is used to hold the sample for observation, is placed on the microscope stage, which is used to hold the device of Douglas-Hamilton et al., of a conventional microscope.

The Appellant further argues that the preambular limitation "a microscope stage" is an essential component of the claims that further defines the structure of the article, and that claim limitations recited in Claims 1 and 9 would be structurally different without the preambles reciting "a microscope stage". The Examiner does not believe that the limitation "a microscope stage" provides any significant structural distinction over the device disclosed by Douglas-Hamilton et al. In addition, as previously stated in the Advisory Action dated 1/13/06, the term "a microscope stage", being preambular in nature, is not afforded significant patentable weight unless structurally distinguishable from the prior art. Since it is believed that Douglas-Hamilton et al. does meet all of the positively recited structural limitations (except for the upper stage having a color, as recited in Claim 9, or the non-transparent contrasting stage insert explicitly being removable, as recited in Claim 1), the device of Douglas-Hamilton et al. also supports the

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title “a microscope stage” in the same manner as the recited structure (See for example MPEP 2111.02). In addition, contrary to Appellant’s assertion that the limitation “a microscope stage” was ignored and not accorded any patentable weight, such limitation was considered during the process of examination and search of the available prior art, however, such limitation was not afforded significant patentable weight for the reasons set forth above.

The Appellant further argues that since claims are given their broadest reasonable interpretation consistent with the specification and the prior art, the device of Douglas-Hamilton et al. must bear some structural resemblance to Appellant’s claimed “microscope stage”. While it is correct (See MPEP 2111) that during patent examination, claims are given their broadest reasonable interpretation consistent with the specification, there is no requirement during examination that the structure of Douglas-Hamilton et al. must bear some structural resemblance to the claimed “microscope stage”, especially where claimed limitations are of broad scope. As previously set forth above, Douglas-Hamilton et al., in combination with the teachings provided by Kapitza et al., disclose all of the claimed limitations of Claims 1 and 9, though the devices of both Douglas-Hamilton et al. and Kapitza et al. do not resemble the device disclosed in Appellant’s drawings.

Thirdly, it is the Appellant’s belief that, with respect to Claims 1 and 9, as well as 2-5, 10-15 which depend on Claims 1 and 9, the combined teachings of Douglas-Hamilton et al. and Kapitza et al. fail to teach, suggest, or motivate the non-transparent contrasting stage insert (See specifically Section 1)c)3) on Pages 10-11 of the Brief filed 4/14/06), as generally recited in Claims 1 and 9. However, it is the belief of the Examiner that the combined teachings of

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Douglas-Hamilton et al. and Kapitza et al. do teach, suggest, or motivate the non-transparent contrasting stage insert.

As previously set forth in Section 9 and 12 of the Final Office Action dated 11/8/05, the holder clamp (See for example 20 in Figure 1; col. 4, lines 40-45 of Douglas-Hamilton et al.) was broadly and reasonably interpreted to read on the limitation “a non-transparent contrasting stage insert comprising a second color”. Appellant argues that Douglas-Hamilton et al. does not provide any teaching or suggestion that the holder clamp can provide a background color for contrast against a specimen that is being positioned on the upper stage. However, as previously set forth in the Advisory Action dated 1/13/06, these features (a specimen, providing a background color for contrast against a specimen, positioning a specimen on the upper stage) are not recited in either Claims 1 or 9. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also MPEP 2145. Further, with respect to Appellant’s arguments that Douglas-Hamilton et al. fails to teach the non-transparent contrasting stage insert comprising a second color *different* from a first color of the upper stage, it is again noted that this feature is not recited in Claim 9. Further, Douglas-Hamilton et al. discloses the holder clamp being constructed from a magnetically susceptible material, e.g. steel, iron, stainless steel, spring steel, or other ferromagnetic material, all of which have particular colors associated with them. Kapitza et al. was evidenced to teach that the stage may be lacquered black (See specifically col. 1, lines 11-12 of Kapitza et al.), specifically for the purpose of maintaining the stage’s good appearance even if the stage becomes contaminated (e.g.

dirt, liquids, spills, etc.). Clearly, if one of ordinary skill viewed both the stage and the stage insert together, the color contrast would be quite evident.

Fourthly, it is the Appellant's belief that, with respect to Claim 6, the combined teachings of Douglas-Hamilton et al., Kapitza et al., and Fischer et al. fail to teach, suggest, or motivate all the recited elements of Claim 6 (See specifically Section 2)c1) on Pages 13-14 of the Brief filed 4/14/06), namely the releasable fastening means comprising a springed detent. However, it is the belief of the Examiner that the combined teachings of Douglas-Hamilton et al., Kapitza et al., and Fischer et al. do teach, suggest, or motivate the releasable fastening means comprising a springed detent.

As previously stated in the Final Office Action dated 11/8/05, the combined teachings of Douglas-Hamilton et al. and Kapitza et al. disclose the non-transparent contrasting stage insert including releasable fastening means (See specifically 20, 32 in Figure 4 of Douglas-Hamilton et al.) which is in the form of magnetic strips. These magnetic strips utilize magnetic force to hold the non-transparent contrasting stage insert against the stage, thus retaining a cover slip and sample slide between the non-transparent contrasting stage insert and the stage, while preventing movement of the non-transparent contrasting stage insert. Fischer et al., which similarly discloses a microscope stage (See for example 9 in Figures 1, 3 of Fischer et al.) and stage inserts (See for example 2a, 2b in Figures 1, 3 of Fischer et al.) in a recess, was evidenced to teach an alternative means for holding the stage inserts while retaining the sample slides. In particular, the stage inserts are releasably held in place by springed detents (See 21a, 21b in Figure 1; col. 2, line 52-col. 3, line 4 of Fischer et al.) such that sample slides of appropriate dimensions may be held in place by the stage inserts and stage. Clearly, the springed detents of Fischer et al. are

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“releasable” in so far as the stage inserts may be retracted into and out of the detent position, where the detent position holds the stage inserts in place. With respect to Appellant’s argument that no express, written motivation appears in Fischer et al., Fischer et al. specifically discloses that the springed detents allow for precise positioning of the stage inserts, since the location of the springed detents define the corners of a rectangle which is dimensioned for the size of a standard specimen slide (See col. 3, lines 1-4 of Fischer et al.). Appellant’s argument is purely argumentative, since no reasonable arguments or evidentiary support have been offered to explain why it would not have been obvious to one of ordinary skill to combine the teachings provided by Douglas-Hamilton et al., Kapitza et al., and Fischer et al.

Fifthly, it is the Appellant’s belief that, with respect to Claim 17, as well as Claims 18-20 which depend on Claim 17, no credible motivation is provided for combining the teachings of Douglas-Hamilton et al. and Sattler (See specifically Section 3)c)1) on Pages 16-17 of the Brief filed 4/14/06). More specifically, Appellant argues that no rational basis for combining the teachings of Douglas-Hamilton et al. and Sattler was provided. However, it is the belief of the Examiner that credible motivation was provided for combining the teachings of Douglas-Hamilton et al. and Sattler.

As discussed in the Final Office Action dated 11/8/05, Douglas-Hamilton et al. discloses a device (See Figures 1-4 of Douglas-Hamilton et al.) for providing contrast between another device that has been broadly and reasonably interpreted to be “a microscope stage” (See arguments above; See 10 in Figure 1 of Douglas-Hamilton et al.) and a specimen (See 21, 23, 25 in Figure 2A; col. 4, lines 9-15 of Douglas-Hamilton et al.), the device including a microscope stage comprising a non-transparent contrasting stage insert comprising a color (See 20 in Figure

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1; col. 4, lines 40-45 of Douglas-Hamilton et al.; As noted above, the stage insert is constructed from a magnetically susceptible material, e.g. steel, iron, stainless steel, spring steel, or other ferromagnetic material, all of which have particular colors associated with them.); and a specimen (See col. 4, lines 9-15 of Douglas-Hamilton et al.). Sattler was evidenced to teach the specimens (e.g. gemstones, See Abstract, Figures 1-2 of Sattler) that may be placed on stage inserts (See 54 in Figures 1-2; col. 4, line 60-col. 6, line 2 of Sattler) on a microscope stage may have a color that is different from the color of the stage inserts. Appellant argues that one may not correlate the stage insert of Douglas-Hamilton et al. with that disclosed by Appellant since Appellant's stage insert is not designed or disclosed as possessing the property of applying or exerting uniform pressure on the edges of a cover slip overlying a specimen volume. However, it is noted that the recitation of "a non-transparent contrasting stage insert" in Claim 17 does not preclude the stage from having other non-recited or non-claimed features, and only requires that the stage insert, at the very least, be non-transparent and have a first color. Further, it appears that Appellant has confused "microscope stage", "contrasting stage insert", and "specimen". Appellant's arguments appear to be drawn to the microscope stage having a color different from the color of the specimen or the color of the stage insert. Yet, Claim 17 recites no particular color limitation for the microscope stage, and instead recites that the contrasting stage insert have a first color and that a specimen have a second color. Again, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also MPEP 2145. With respect to Appellant's argument regarding motivation to combine, Sattler specifically discloses that the specimen may have a color that is different from the stage insert to allow for higher

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contrast, while maintaining or reproducing accurate and true color of the specimen during viewing of the specimen (See specifically col. 4, line 53-col. 6, line 2 of Sattler). Again, the Examiner notes that this particular reason or motivation to combine these teachings comes directly from Sattler. As per MPEP 2144, such reason or motivation to combine may be different from Appellant's rationale. Further, Appellant's argument regarding color contrast and image quality is purely argumentative, since no reasonable arguments or evidentiary support have been provided to support Appellant's position.

Finally, it is the Appellant's belief that, with respect to Claim 17, as well as Claims 18-20 which depend on Claim 17, the combined teachings of Douglas-Hamilton et al. and Sattler fail to teach, suggest, or motivate the non-transparent contrasting stage insert of Claim 17 (See specifically Section 3)c)2) on Page 18 of the Brief filed 4/14/06). However, it is the belief of the Examiner that the combined teachings of Douglas-Hamilton et al. and Sattler do teach, suggest, or motivate the non-transparent contrasting stage insert of Claim 17.

As previously set forth above as well as in the Final Office Action dated 11/8/05, Douglas-Hamilton et al. specifically discloses a non-transparent contrasting stage insert (See 20 in Figure 1 of Douglas-Hamilton et al.) in the form of a holder clamp constructed from a magnetically susceptible material, e.g. steel, iron, stainless steel, spring steel, or other ferromagnetic material, all of which have particular colors associated with them and all being non-transparent. As Douglas-Hamilton et al. already teaches this limitation, Sattler was cited merely to evidence that a specimen may have a color that is different from the color of the non-transparent contrasting stage insert. It is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, as previously set forth in Section 14 of the Office Action dated 11/8/05, Sattler specifically discloses a device that has been broadly and reasonably interpreted to be “non-transparent contrasting stage insert” (See 54 in Figures 1-2; col. 4, line 60-col. 6, line 2 of Sattler), wherein the stage insert of Sattler may be made of particular materials, such as Plexiglas of Type 010 which is 66% translucent or Plexiglas of Type 072 which is 24% translucent and milky, chosen on the basis of the specimen (i.e. gemstone) to be viewed.

Clearly, these particular materials do not show pure transparency, nor do they show pure opacity. Thus, they are reasonably interpreted to be translucent, or ‘non-transparent’. It is believed that taking judicial notice that the commonly accepted definition of transparent is to allow light to travel through it, and thus a non-transparent specimen holder would not allow light to travel through it would not be proper, especially since Appellant’s own disclosure cites a wide range of materials and objects that may comprise a stage insert (See for example Paragraph 0022 of Appellant’s disclosure which discloses aluminum, metals, coated metals, plastics, ceramics; *Paragraph 0023 which discloses solid or hollow materials that are translucent*; Paragraph 0025 which discloses painted surfaces, adhesive films, stickers, and magnets). Thus, the Examiner, it is believed, has broadly and reasonably interpreted the term ‘non-transparent’ to include translucent (where only part of the incident light passes through the material) materials as well as opaque (where no part of the incident light passes through the material) materials.

With regard to the remaining dependent Claims 2-5, 10-15, 18-20, since Appellant’s only argument is that these are allowable based on their dependency on Claims 1, 9, and 17, then the aforementioned rejections of these claims stand since Claims 1, 9, and 17 remain rejected.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Arnel C. Lavarias
Primary Examiner
Group Art Unit 2872
6/27/07

Conferees:



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